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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,125	05/22/2001	Elizabeth S. Light	6270-709.301	9583
21971	7590	02/02/2006	EXAMINER	
WILSON SONSINI GOODRICH & ROSATI			SISSON, BRADLEY L	
650 PAGE MILL ROAD			ART UNIT	
PALO ALTO, CA 94304-1050			PAPER NUMBER	

1634

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Examiner-Initiated Interview Summary	Application No.	Applicant(s)	
	09/863,125	LIGHT, ELIZABETH S.	
	Examiner	Art Unit	
	Bradley L. Sisson	1634	

All Participants:
Status of Application: 061

 (1) Bradley L. Sisson.

(3) _____.

 (2) Shirley Chen, Ph.D., Esq.

(4) _____.

Date of Interview: 30 January 2006
Time: 2015
Type of Interview:

- ☒ Telephonic
☐ Video Conference
☐ Personal (Copy given to: ☐ Applicant ☐ Applicant's representative)

 Exhibit Shown or Demonstrated: ☐ Yes ☐ No

If Yes, provide a brief description:

Part I.

Rejection(s) discussed:

Possible 103(a) rejection of draft claims submitted 24 January 2006 via e-mail (attached hereto)

Claims discussed:

27, 29, and 30

Prior art documents discussed:

See Continuation Sheet
Part II.

SUBSTANCE OF INTERVIEW DESCRIBING THE GENERAL NATURE OF WHAT WAS DISCUSSED:

See Continuation Sheet
Part III.

- ☐ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview directly resulted in the allowance of the application. The examiner will provide a written summary of the substance of the interview in the Notice of Allowability.
☒ It is not necessary for applicant to provide a separate record of the substance of the interview, since the interview did not result in resolution of all issues. A brief summary by the examiner appears in Part II above.


 (Examiner/SPE Signature)

 (Applicant/Applicant's Representative Signature – if appropriate)

Continuation of Identification of prior art discussed: Vernole, "Digoxigenin-Labeled Probes Can Detect Single-Copy Genes in Human Metaphase Chromosomes," Biotechniques, Vol. 9, No. 2, (1990), pp. 200-204. Davison et al., "Subtracted, Unique-Sequence, In Situ Hybridization," American Journal of Pathology, Vol. 153, No. 5, November 1998, pp. 1401-1409. US Patent 4,935,341 (Bargmann et al.).

Continuation of Substance of Interview including description of the general nature of what was discussed: The Draft amendment to the claims, submitted via e-mail on 24 January 2006 from Dr. Chen was discussed. Mr. Sisson directed attention to the publications of Davidson et al., and Vernole. Mr. Sisson noted that Vernole teaches explicitly of detecting single-copy genes via in situ hybridization where the probe was labeled with digoxigenin, and hybridization products were detected using anti-digoxigenin antibodies that were labeled with alkaline phosphatase. Dr. Chen indicated that she would be willing to narrow the claims to where the assay was testing tissue samples and not free cells. Mr. Sisson noted that Davison et al., taught detecting chromosomal sequences where the cells were in a tissue section that had been formalin-fixed and paraffin embedded. Mr. Sisson noted that the assay utilized biotinylated probes and not digoxigenin, but that digoxigenin and biotin are considered to be functional equivalents, directing attention to the Markush group found at page 11, first paragraph, of the specification.

Dr. Chen stressed the limitation that the claim is directed to the detection of a single copy of nucleic acid in the nucleus using in situ hybridization, digoxigenin probes, and brightfield microscopy and that no piece of art taught all of these limitations. And that while Davison does teach in situ hybridization, including the hybridization of probes to specific chromosomal regions, the cells depicted in Figures A-H were not in a tissue but in a cell sample, and embodiment that applicant is willing to amend around.

Mr. Sisson indicated that he appreciated applicant's willingness to amend the claims to where they were directed to a tissue section and not tissue and/or cell sample. Mr. Sisson also noted that he would search the art further.

Sisson, Bradley

From: Chen, Shirley [xSChen@wsgr.com]
Sent: Tuesday, January 24, 2006 9:45 PM
To: Sisson, Bradley
Cc: Norviel, Vern
Subject: Claim List and Copy of Figure 1-3 (09/863,125; Attorney Docket No. 6270-709.301)

Dear Examiner Sisson,

It was a very pleasant and constructive telephone interview with you regarding Application Serial No. 09/863,125 this afternoon. We would like to express our appreciation to you for conducting the interview with us.

Attached please find the materials we discussed during the interview.

Please do not hesitate to contact us if you need us to provide more information or if you have any questions.

Thank you very much.

Sincerely,

Shirley

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<<ClaimList.709.301.Jan2005_(PALIB1_2807867_1).DOC>> <<2006-01-24_18-31-05.pdf>>